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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/563,804

07/07/2006

Johannes Franciscus Van De Sanden

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EXAMINER

CHARLES, MARCUS

ART UNIT

PAPER NUMBER

3682

NOTIFICATION DATE

DELIVERY MODE

08/20/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ADIPFDD@bipc.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/563,804	<b>Applicant(s)</b> VAN DE SANDEN ET AL.	
	<b>Examiner</b> Marcus Charles	<b>Art Unit</b> 3682	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 January 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1-9-2006</u>  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

This is the first action relating to serial application number 10/563,804 filed 07-07-2006.

Claims 1-20 are currently pending.

#### ***Drawings***

1. The examiner has accepted the drawing filed with this application as formal drawing.

#### ***Priority***

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

#### ***Specification***

##### **Abstract**

3. The abstract of the disclosure is objected to because it is not proper to use the phrases "such as" and "e.g." because it is not clear if the items the phrases are referring to is part of the invention. Correction is required. See MPEP § 608.01(b).
4. The disclosure is objected to because of the following informalities: the specification is following sub-titles.

(I) CROSS-REFERENCE TO RELATED APPLICATIONS.

(II) BACKGROUND OF THE INVENTION.

(1) Field of the Invention.

(2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.

(III) BRIEF SUMMARY OF THE INVENTION.

(IV) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).

(V) DETAILED DESCRIPTION OF THE INVENTION.

Appropriate correction is required.

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The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

### **Arrangement of the Specification**

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT.
- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC.
- (f) BACKGROUND OF THE INVENTION.
  - (1) Field of the Invention.
  - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (g) BRIEF SUMMARY OF THE INVENTION.
- (h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (i) DETAILED DESCRIPTION OF THE INVENTION.
- (j) CLAIM OR CLAIMS (commencing on a separate sheet).
- (k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

In addition, the specification is replete with the legal term "said". It is not proper to include legal terms in the specification. For example see page 1, line 12; page 4, line 1 and page 7, line 2.

### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

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art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 11-12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification does not describe the connection means connecting the two metal parts of the bearing means are high grade material such as low carbon steel, high strength steel or stainless steel etc. In addition the specification fails to disclose connection means are light weight material such as aluminum, titanium etc.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The intended scope of claims 1, 3, 9 and 14 is confusing because it is not clear if the phrase "and /or" is an inclusive or exclusive phrase. For example, in claim 1, it is not clear if the connection means comprises both brazed and soldered connection in the same instant or comprises a brazed or soldered connection.

9. In addition, claims 2, 12, 13, 16-18 and 20, the phrase "for example" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

In claim 1, the phrase "metal means part" and "bearing means" are unclear and confusing because it is not clear as to what is the function of the means.

Regarding claims 1, 3-5, 9, 11, 14-15 and 17, the word "means" is preceded by the word(s) "bearing" "metal", "ring" and "brake means" respectively, in an attempt to use a "means" clause to recite a claim element as a means for performing a specified function. However, since no function is specified by the word(s) preceding "means," it is impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967).

In claim 2, the intended scope of the claim is confusing because it is not clear as to what the further connection means is related to and it is also not clear if the connection is connected via the connection means of the claim. Claim 2 is totally confusing.

In claim 3, it is not clear if the "connection means" and the "brazing and/or soldered connection" are the same as that of claim 1. If they are the same then there includes a double inclusion.

In claims 12-13, it is not clear as to how the connection means can be braze or soldered joint and at the same time comprises high grade steel or light weight such as aluminum etc.

### ***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1, 3 and 11, as understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Haller (3,241,893). Haller discloses a bearing unit comprising at least two bearing elements (12, 14) which are supported with respect to each other, at least one of the bearing elements comprises two metal parts (72, 74) which are connected to each other by brazing connection.

In claim 3, as understood, Haller discloses the bearing elements as rings.

In claims 11, as understood, Haller discloses the claimed invention

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 1, 3-4, 9-11 and 14, as understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Asberg (3,583,511) in view of Haller (3,241,893). Asberg discloses a bearing unit comprising two bearing elements (8, 12), which are displaceably supported with respect to each other, at least one of the bearing elements (8) comprises two metal parts which are connected to each other. Asberg does not disclose the bearing elements with the two metal elements are connected by brazing. Haller discloses a bearing having two bearing elements with at least one element comprising two metals (16/18) that are connected by brazing. Therefore, it would have

been obvious to one of ordinary skill in the art at the time of the invention to modify the device of Asberg so that the inner race comprising two metals are connected by brazing in view of Haller in order to reduce brittleness at the connection, Prevent the races from inadvertent movement and to reduce the development of stress at the joints.

In claim 4, Haller discloses the intermediate ring part (64/148) between the two bearing elements (16/18).

In claim 3, as understood, Haller discloses the bearing elements as rings.

In claim 9, as understood, Haller discloses the rings and the intermediate ring parts constitute an inner ring.

In claim 10, as understood, Haller discloses the claimed invention.

In claim 11, as understood, Asberg discloses the bearing elements are slidable supported with respect to each other.

Regarding claim 14, as understood, the combination of Asberg and Haller fails to disclose the bearing element comprises a ceramic component. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the bearing elements of Asberg so that it is made from ceramic, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416. As well known in the art ceramic material is known for its light weight and corrosive resistance.

14. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Asberg in view of Haller as applied to claim 2 above, and further in view of JP (05-2002943). The



combination of Asberg and Haller fails to disclose a connection that requires welding. JP (05-202943) discloses a bearing race comprising two parts (61/62) that is connected by welded joint (11). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the joints of Asberg and Haller device so that the joints are connected by welding in view of JP (05-202943) in order to create a strong joint that can support high fluctuating loads.

15. Claims 15-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hacker (6,616,340) in view of Haller (3,241,893). Hacker discloses a bearing unit comprising two bearing elements (2/4), which are displaceable supported with respect to each other, at least one of the bearing elements (22) comprises two metal parts (22/77), which are connected to each other, and an auxiliary unit in the form of a brake drum (3) connected to the bearing element ((22) . Hacker does not disclose the bearings elements with the two metal elements are connected by brazing. Haller discloses a bearing having to bearing elements with at least one element comprising two metals (16/18) that are connected by brazing. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the device of Hacker so that the inner race comprising two metals are connected by brazing in view of Haller in order to reduce brittleness at the connection, prevent the races from inadvertent movement and to reduce the development of stress at the joints.

In claim 16, as understood, note hacker discloses a further connected that is screwed by a bolt (30).

In claim 19, as understood, note the auxiliary unit comprises a mounting flange of a brake unit.

Regarding claims 18 and 20, as understood, Hacker and Haller do not disclose the auxiliary unit comprises a cooling element and the mounting flange comprises cast iron. It would have been obvious to one of ordinary skill in the art at the time of the invention of Hacker so that the auxiliary unit is a cooling element, since it has been, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikes*, 86 USPQ 70. In addition, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the flange of Hacker so that it is made from cast iron, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. as well known cast iron is suitable for operation in a high temperature environment without succumbing to the heat.

#### ***Allowable Subject Matter***

16. Claims 5-8 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

#### ***Citation***

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Note the prior art cited in attached PTO Form 892.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marcus Charles whose telephone number is (571) 272-7101. The examiner can normally be reached on Monday-Thursday 7:30 am to 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ridley Richard can be reached on (571) 272-6917. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

*Marcus Charles*  
/Marcus Charles/  
Primary Examiner, Art Unit 3682